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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,277

03/26/2004

Frits Goedegebuur

GC794-2

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7590

07/03/2006

GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
925 PAGE MILL ROAD
PALO ALTO, CA 94304

EXAMINER

CHOWDHURY, IQBAL HOSSAIN

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,277

Applicant(s)

GOEDEGEBUUR ET AL.

Examiner

Iqbal Chowdhury, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, and 17, drawn to an isolated variant polypeptide having cellobiohydrolases 1 activity, classified in class 435, subclass 209.
- II. Claims 6-16, drawn to an isolated polynucleotide encoding polypeptide having cellobiohydrolases 1 activity, classified in class 435, subclass 252.3 and 209.
- III. Claim 18-19, drawn to a method of converting biomass to sugars comprising contacting the biomass with a polypeptide having cellobiohydrolases 1 activity, classified in class 435, subclass 99.

For each of inventions I-III above, restriction to one of the following is also required under 35 USC121. Therefore, election is required of one of inventions I-III and one of inventions (A) – (I).

- (A). variant protein of SEQ ID No: 3 or a nucleic acid encoding SEQ ID No: 3.
- (B). variant protein of *Hypocera jecorina* having a substitution of threonine at position 55 with glutamic acid (T55E) or a nucleic acid encoding the said variant.
- (C). variant protein of *Hypocera jecorina* having a substitution of serine at position 58 with lysine (S58K) or a nucleic acid encoding the said variant.
- (D). variant protein of *Hypocera jecorina* having a substitution of glutamine at position 101 with tyrosine(Q101Y) or a nucleic acid encoding the said variant.

Art Unit: 1652

(E). variant protein of *Hypocera jecorina* having a substitution of asparagine at position 250 with aspartic acid or glutamic acid (N250D or E) or a nucleic acid encoding the said variant.

(F). variant protein of *Hypocera jecorina* having a substitution of proline at position 265 with alanine or serine (P265A or S) or a nucleic acid encoding the said variant.

(G). variant protein of *Hypocera jecorina* having a substitution of leucine at position 288 with isoleucine(L288I) or a nucleic acid encoding the said variant.

(H). variant protein of SEQ ID No: 4 or a nucleic acid encoding SEQ ID No: 4.

(I). variant protein of SEQ ID No: 11 or a nucleic acid encoding SEQ ID No: 11.

The inventions are distinct, each from the other because of the following reasons:

2. The DNA of Group II and the protein of Group I each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The DNA comprises a nucleic acid sequence of group II and the protein of Group I comprises amino acid sequences. The DNA has other utility besides encoding the proteins such hybridization or probe preparation and the proteins can be made by another method such as isolation from natural sources or chemical synthesis.

3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be used for the materially different process of inducing an antibody.

Art Unit: 1652

4. Inventions polynucleotide Group II is unrelated to the method of Group III as polynucleotide of Group II is neither used nor made by the method of Group III as polynucleotide has different modes of operation and different functions.

5. The proteins of Group (A)-(I) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides and polynucleotide encoding them. Therefore, where structural identity is required, such as for hybridization or expression or antibody binding, the different sequences have different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37CFR 1.48b if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the imitations of the**

Art Unit: 1652

patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal H. Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00.

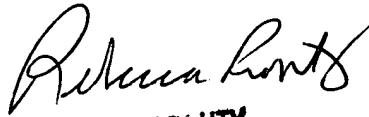
Art Unit: 1652

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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